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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/956,888	09/21/2001	Sachiko Tajima	211653US0	2424

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EXAMINER	
GOLLAMUDI, SHARMILA S	
ART UNIT	**PAPER NUMBER**
1616	

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/956,888	TAJIMA ET AL.	
	Examiner	Art Unit	
	Sharmila S. Gollamudi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5,6,13-17,19 and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5,6,13-17,19 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt for Request for Continued Examination, Information Disclosure Statement, and Amendments/Remarks received on March 19, 2004 is acknowledged. Claims **1, 3, 5-6, 13-17, and 19-20** are pending in this application.

Information Disclosure Statement

The information disclosure statement filed March 19, 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Non-patent literature by Indou does not have an English translation or an English abstract. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1). It should be noted that the other references contained in the IDS have been considered.

Specification

The amendment filed March 19, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant has amended the fragrances listed on page 3 and 4 of the specification; however some of these fragrances do not have support. For instance, applicant has amended "β-methyl ionone" to "γ-methyl ionone". If applicant contends

there is support for such an amendment, then the applicant is requested to cite the specific page and line in the instant specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1, 3, 5-6, 13-17, and 19-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended the independent claims to recite cis-3-hexanol in the amount of 20 to 50%; however applicant does not have support for such a range. A careful review of the instant specification lends support for a range of 0.01-50% with a preference for 1-30%. See page 3. Further, page 4 recites a range of 0.1-1% and 0.3-0.8%. However, the specific range of 20-50% excluding the lower limit, i.e. 0.01-20%, is not taught nor disclosed.

Further, applicant has amended "β-methyl ionone" to "γ-methyl ionone" in claim 4, which does not have support in the instant specification.

If applicant contends there is support for such an amendment, then the applicant is requested to cite the specific page and line in the instant specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 5-6, and16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites that a fragrance selected from cis-3-hexanol esters and list alcohol C-6 as part of the Markush group. This is vague and indefinite since if applicant is claiming an alcohol with 1-6 carbons and if so, this is not within the scope of cis-3-hexanol esters. Further, clarification is requested.

Claims 5-6 depend on the independent claim 1 that requires 20 to 50% of cis-3-hexanol. However, claim 5 recites 0.1 to 1% of cis-3-hexanol and claim 6 recites 0.3-0.8% cis-3-hexanol which does not fall within the range recited in the parent claim.

Lastly, claim 16 recites the use of an additive and lists fragrance as part of the Markush group. This is indefinite since claim 16 depends on claim 1, which requires fragrance. Therefore, further clarification is requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 5-6, 13-17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2033939 in view XP-002226338.

GB teaches a low ammonia bleach composition. Examples 1 discloses a composition containing 2-20% of an ammonium or alkali earth metal persulfate, perborate, percarbonate, carbonate, 1.5 -7% of hydrogen peroxide, monoethanolamine, a buffer, and water. Note example 1-3. The reference discloses that the composition produces trace amounts of ammonia gas. See page 3, lines 37-45. Additives such as perfume and essential oils up to 20% is taught on page 3, lines 114-117 and examples. The composition is maintained at a pH of 9-12. See abstract,

The reference does not specify the perfume utilized.

XP teaches a perfume composition that deodorizes ammonia odor produced by components contained in cosmetics. The perfume composition contains one or more of cis-3-hexenol, geraniol, linalool, terpineol, etc.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings the teachings of GB and XP and include XP' s perfume composition into GB's hair composition. One would be motivated to do so to deodorize the ammonia gas that is produced by the hair product taught in GB.

It is deemed obvious to one of ordinary skill in the art at the time the invention was made to manipulate the amount of perfume contained in GB since the concentration of perfume is a variable factor and is dependent on the desired aroma in the final product. If a strong aroma is desired, then one would increase the amount of perfume contained in the formulation whereas a low concentration would be utilized to yield a subtle aroma. Absent the criticality of the instant amount, it is deemed prima facie obvious.

Response to Arguments

Applicant argues that GB '939 does not teach cis-hexanol and this is a critical feature of the instant invention. The instant invention masks the odor of monoethanolamine. Applicant argues that the secondary reference '338 only teaches that the fragrances incorporated mask the smell of ammonia. It is argued that there is no teaching or suggestion of masking the odor of monoethanolamine.

Applicant's arguments have been fully considered but they are not persuasive. First, the examiner points out that the claims are rejected under prima facie and not under anticipation. Therefore, the primary reference neither has to exemplify formulations or teach every element of the instant invention, or the reference would be said to anticipate the instant invention. The reference merely has to suggest the modification. This is clearly done wherein GB teaches the use of fragrances in the hair composition. It is further pointed out that GB teaches the amount of the fragrance up to 20%, which includes the newly amended scope of 20-50%. Further, on page 3, GB teaches that the a cosmetic formulation without that much ammonia gas is pleasing and therefore endeavors to reduce the unpleasing smell. The only teaching that is lacking is that of the instant fragrance: cis-3-hexanol. The secondary reference supplies the deficiency. The

secondary reference teaches the instant fragrance deodorizes the ammonia odor in cosmetics. Therefore, the motivation to utilize the instant invention is to mask the remaining ammonia gas that is produced in GB's hair formulation. One would expect similar results since GB teaches the suitability of fragrances in the formulation and the formulation contains ammonia. Further, both references are in the same field of endeavor, i.e. to reduce the ammonia odor in a hair dye composition.

Second, the examiner points out that the instant claims are product claim, therefore the function of an ingredient, i.e. cis-hexanol masks monoethanolamine, in a product claim does not hold patentable weight. Thus, the examiner's reason for combining the references may differ from the applicant but the combination yields the same product as the applicant. The fact that applicant has recognized another advantage; i.e. that cis-hexanol masks the odor of monoethanolamine, which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Therefore, for the reasons above, the rejection is maintained.

Claims 1-3, 5-6, and 13-20 under are rejected 35 U.S.C. 103(a) as being unpatentable over Yasuda et al (5,817,155 in view of Fragrance Journal (June 1993) in further view of optionally in further view of Mussinan et al (4,335,002).

Yasuda et al teach a hair treatment formulation such as hair dyes, hair bleaches, and permanent wave agents. The instant color developing agents and coupling agents are taught on column 2, line 51 to column 3, line 30. The main agent in the permanent wave formulation is a reducing agent such as thioglycolate. See column 3, lines 44-67. Example 6 discloses a

formulation containing 1% monoethanolamine, aqueous ammonia, 1% ammonia thiglycolate, 1% paraphenylenediamine, 0.3% metaaminophenol, water, and perfume to an appropriate amount, among other components. It is the examiner's position that the examples relied upon for the rejection fall within the instant pH range since the examples are basic hair formulations.

Yasuda et al do not specify the perfume utilized.

The publication teaches perfumes such as cis-hexenol that mask wave lotions containing ammonium thioglycolates in the base composition. The composition contains 0.1% cis-hexenol applied to a base composition containing ammonium thioglycolate, 1.2% ammonia water, and propylene glycol among other components (Note Table 2 and Table 3).

Mussinan et al teach cis-hexenol and its derivatives for a variety of uses such as flavoring, perfumed articles, and cosmetics. The cosmetics that are mentioned are soaps, colognes, hair preparations, and lotions. The cis-hexenyl derivatives may be utilized as little as 0.5% or up to 50% depending on the consideration of cost, nature of the end product, the effect desired on the finished end product and particular fragrance sought. Cis-hexenol provides a green leafy aroma. See column 1, lines 44-58. Cis-3-hexenol is taught in combination with other fragrances such as eugenol, linalool, geraniol, etc. See examples. The examples on column 25 discloses the amount of cis-hexenol produces different aromas. For instance, at a high concentration such as 15%, 20%, 25%, 30%, and 40% the composition produces an intense green, leafy aroma with a strong jasmine note wherein at a concentration for instance 2%, the aroma produced is spicy aroma with leaf alcohol nuances.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings Yasuda et al, Fragrance Journal, and Mussinan et al and

include the instant perfume in the instant amount. One would be motivated to do so since the Fragrance Journal teaches cis-hexenol effectively masks base compositions containing ammonia and ammonium thioglycolates. Therefore, since Yasuda et al teach a hair dye formulation containing ammonium thioglycolate, a skilled artisan would reasonably expect cis-hexenol to have similar masking capabilities in Yasuda's composition. Therefore, it is prima facie obvious to cis-hexenol to mask the odors of a hair composition this is a known concept in the art. It is deemed obvious to one of ordinary skill in the art at the time the invention was made to manipulate the amount of perfume contained in Yasuda et al since the concentration of perfume is a variable factor and is dependent on the desired aroma in the final product. If a strong aroma is desired, then one would increase the amount of perfume contained in the formulation whereas a low concentration would be utilized to yield a subtle aroma. Absent the criticality of the instant amount, it is deemed prima facie obvious.

Additionally, one would be motivated to look to Mussinan et al and utilize and higher concentration of the cis-hexenol to produce a more intense, jasmine aroma whereas a lower concentration produces a subtle aroma. Therefore, it is prima facie obvious to include the desired amount depending on desired aroma in the end product.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection based on the amendments.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5-6, 13-15, 17, 19-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/404083. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter recited in both applications are obvious modifications of each other.

The instant application recites a hair composition containing 20-50% cis-hexenol and monoethanolamine in an oxidation hair color or hair bleaching formulation. Claims 5-6 recites the amount of cis-hexenol in the amount of 0.1-1% and 0.3-0.8% respectively. Claims 13-15 recite color developing agents and coupling agents.

Co-pending application recites a hair composition containing cis-3-hexenol and monoethanolamine. Claims 2 and 7 recite the monoethanolamine in a oxidation hair coloring or hair bleaching composition. Claims 3-4 recite the amount of cis-hexenol in the amount to mask the odor of monoethanolamine and provide a desirable fragrance respectively. Claims 5-6 recite the wherein the amount of cis-hexenol is 0.1-50% and 1-50% respectively.

The above applications are obvious modifications that contain similar subject matter. The co-pending application claims the generic composition and the instant application claims the

species. Therefore, the instant application falls within the scope of the co-pending application and this anticipates co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharmila S. Gollamudi
Examiner
Art Unit 1616

SSG

MICHAEL G. HARTLEY
PRIMARY EXAMINER